

RESPONSE under 37 C.F.R. § 1.111
U.S. Appl. No. 10/719,537

REMARKS:

Claims 1-22 are all the claims pending in the present application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

PRIOR RESPONSE.

By virtue of the previous prior art rejections NOT being reasserted in the instant Office Action, Applicant presumes the previous prior art rejections of record have all been withdrawn in light of Applicant's prior response.

OBJECTIONS.

The Office Action objects to claims 7-8, 10-11 and 13-14 as failing to further define the subject matter of a previous claim. Specifically, the Office Action alleges that since independent claim 6 does not positively recite "the electronic device" it is improper to further define the electronic device in subsequent dependent claims. Applicant respectfully disagrees. Applicant notes that the type of electronic device which the casing is configured to hold necessarily further defines the casing itself (e.g., the size and configuration of the casing for holding a watch module, a cell phone, an MP-3 player, etc.). Notwithstanding, by the foregoing amendments, Applicant addresses the Examiner's concerns. Reconsideration is respectfully requested.

CLAIM REJECTIONS.

35 U.S.C. §102

Claims 1-3, 6-8 and 10-15 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,781,512 to Pantet. Applicant respectfully traverses this rejection for the following reasons.

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Pantet discloses a conventional watch 1 and a suspension and support device 2 on which watch 1 is mounted in a removable manner. (Col. 3, ll. 22-25). Suspension and support device 2 (illustrated in detail in Figs. 3-5) includes a first part 11 and a second part 12. First part 11 is for removably holding the outer casing 3 of pocket watch 1. Second part 12 has the general shape of a substantially flat and rectangular ring and is connected to first part 11 via hinge 13. (Col. 3, ll. 38-66). Both parts 11 and 12 are configured so a conventional watch 1 may be suspended from a chain as well as enable the watch to be placed on a piece of furniture and so that the watch requires little space, for example when it is placed in a pocket of a garment. (Col. 4, ll. 7-10). Part 12 (rectangular ring) is shaped to form a suspension element allowing a snap hook 40 of a small suspension chain 41 to secure it. (Col. 4, ll. 11-14). Pantet discloses throughout that a main advantage/premise of its invention is to reduce the "bulky" nature of previous pocket and table watch configurations so that it is more convenient to carry in a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). Applicant lastly notes that Pantet, which discloses and claims only minor variations to many years of previous pocket watch configurations was issued as a patent in 1998.

Regarding Applicant's independent claims 1 and 6, the Office Action alleges that Pantet discloses Applicant's claimed *attachment section configured to be attachable to an object of interest*. Applicant respectfully disagrees. Pantet discloses only a rectangular ring 12 to which other articles (e.g., a hook 40 on a suspension chain) are configured to be attached. Ring 12 is not configured to be *attachable* to an object of interest.

As Pantet discusses only conventional pocket watches, Applicant further submits that Pantet does not disclose "*an electronic device*" as claimed in many of Applicant's claims (e.g., 6-8, 11, 13 or 15) (i.e., a pocket watch may be entirely mechanical). To this end, Applicant respectfully submits that the allegations on page 4, paragraphs g.-j. and page 5, paragraph l. of the 10/31/2005 Office Action are entirely unfounded and unsupported. Respectfully, even an unreasonably broad interpretation of Pantet cannot allege that Pantet discloses, mentions or

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remotely suggests a temperature sensor, MP3 player, multi-function display device, cell phone, PDA, calculator, digital camera, altimeter, compass or radio communication device as recited in Applicant's claims 10-11, 13 and 15.

Notwithstanding the foregoing, in an attempt to advance the prosecution of this application, Applicant amends independent claims 1 and 6 to more clearly define the attachment section as formed as a clip (similar to what is already recited in independent claim 16). Since Pantet element 12 is clearly not a clip or does not include a clip, there is no *prima facie* anticipation and reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103

1.) Claims 4, 9 and 16-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pantet in view of some combination of previously cited references including U.S. Patent 5,540,367 to Kauker, U.S. 6,751,164 to Sekiguchi, U.S. 6,801,476 to Gilmour, U.S. 4,022,014 to Lowedenslager. Applicant respectfully traverses these rejections for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In the instant rejections, the Office Action relies on Pantet to disclose the majority of Applicant's claim limitations with the exception of a *clip* (claim 16) or a carabiner clip (claims 4, 9). The Office Action relies on Kauker to make up for this notable deficiency alleging "[i]t would have been obvious to a person having ordinary skill in the art.... to modify Pantet to include a carabiner clip in the attachment section...[to increase] the functionality of the watch by

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allowing it to be easily attached to a wide variety of objects [thereby increasing] the commercial profitability of such a watch." Applicant respectfully disagrees and submits that (I) there is no proper motivation for combining/modifying the references as suggested and (II) even when combining the references as proposed in the Office Action, the resulting combination still fails to teach or the limitations present Applicant's independent claims.

(I) NO PROPER MOTIVATION TO COMBINE/MODIFY REFERENCES

The Office Action alleges it would be obvious for the skilled artisan to modify Pantet with the carabiner clip of Kauker to increase "the functionality of the watch by allowing it to be easily attached to a wide variety of objects." However, Pantet is devoted to a specific application for pocket watches and attaching pocket watches to a suspension chain 41 that already includes a "snap hook" 40. Accordingly, Pantet provides no motivation in the reference itself to modify "it to be easily attached to a wide variety of objects." Furthermore, Kauker is a design patent and does not provide any suggested benefit or motivation in use of its watch hanger. Accordingly, since neither reference provides the suggested motivation, the Office Action is apparently basing the alleged motivation to combine/modify references solely on the "knowledge generally available to one of ordinary skill in the art" in making the instant rejections.

It is respectfully submitted that the proposed modification is expressly contrary to the teachings of Pantet and in fact Pantet itself teaches away from the modification/combination suggested in the Office Action. By way of example, and as duly noted above, a primary goal of Pantet is to reduce the "bulky" nature of previous prior art pocket and table watch configurations so that the resultant product can fit easily or conveniently into a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). To this end, Pantet shows, by virtue of Fig. 1 and 3 that its ring 12, should be relatively small and not cumbersome, while still be able to provide vertical support (table top configuration), to be manageable to carry around in one's pocket.

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By way of contrast, referring to Figs. 1-3 of Kauker, the carabineer clip shown is larger than the watch itself and thus would most certainly add significant weight/bulk if combined with Pantet. This is in direct contrast to the express teachings and purpose of Pantet. Further since Pantet teaches that the suspension and support device 2 is specifically designed for attaching to a pocket watch chain 41 which has its own clip 40, it is contrary to the teaching in Pantet to form ring 12 as a clip itself.

Lastly, the alleged motivation for modifying the pocket watch of Pantet is to enable a watch "to be easily attached to a wide variety of objects." However, since Kauker apparently teaches a watch hanging device, which includes the clip that allegedly could "be easily attached to a wide variety of objects," there would be no need to modify or combine the teachings of Pantet since Kauker already discloses such a device in and of itself.

Because the proposed motivation for combining/modifying Pantet with Kauker is not present in either of the cited references, and in fact the cited references provide many reasons against the proposed combination/modification, Applicant submits there is no objective motivation to support their combination. Instead, it appears that the only motivation to modify Pantet with the clip of Kauker is solely an attempt to reconstruct Applicant's claims in piecemeal fashion using the improper hindsight of Applicant's disclosure as a guide. Because there is no proper motivation for combining/modifying the teachings of Pantet with Kauker as proposed in the Office Action, *prima facie* obviousness has not been established.

(II) THE RESULTING COMBINATIONS FAIL TO TEACH OR SUGGEST ALL OF APPLICANT'S CLAIM LIMITATIONS.

Even assuming it would be proper to combine the teachings of Pantet with those of Kauker (*arguendo*), Applicant respectfully submits the resultant combination would fail to teach or suggest the limitations of Applicant's independent claims 1, 6 and 16 (and the remaining dependent claims at least by virtue of their dependencies). By way of example with respect to

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claim 16, Applicant submits that even the combination of Pantet and Kauker does not teach or suggest *a clip pivotally attached to the casing, the clip configured to be attachable to an object of interest, the clip configured to be pivoted to form a stand for the apparatus.*

Kauker shows a watch body having an axial member fixed thereto. An intermediate member (e.g., elastic or cloth) connects the axial member of watch body to a clip. On the opposing end of the intermediate cloth member, the clip is attached. Respectfully, even when combining the teachings of Pantet with Kauker, the most that the resulting combination could produce appears to be the suspension and support device 2 of Pantet suspended by the intermediate cloth member and clip of Kauker. For example, the Kauker intermediate cloth member would be attached to the Pantet small cylindrical bar 28 and/or thicker adjacent portions 29 and the Kauker clip would be entirely separate (by the extension of the intermediate cloth member) from the Pantet suspension and support device 2.

Pantet and Kauker, taken alone or in combination, fail to teach or suggest *a clip which forms a stand (or maintains a display device in a substantially upright position)* as recited in Applicant's independent claim 16 (or 1). Similar limitation are present in Applicant's independent claim 6.

The remaining secondary references (e.g., Sekiguchi, Gilmour and/or Lowedenslager), without acquiescence as to the properness of their proposed respective combinations¹, also fail to make up for the deficiencies of Pantet and Kauker noted above. Since even the combination of all cited references of record fail to teach or suggest the clip or stand as recited in Applicant's independent claims, there is no *prima facie* obviousness with respect to any claim.

¹ Applicant does not address the specific merits of the rejections relying on the remaining secondary references because of the failings of the Pantet and Kauker render addressing these references moot. Applicant reserves the right to dispute specifics of these rejections if later deemed necessary for purposes of Appeal.


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For all the foregoing reasons, Applicant respectfully submits all the pending claims are patentable over the cited art of record and requests reconsideration and withdrawal of all §103 rejections of record.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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